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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85206022
Applicant	COLAKEL, KEMAL
Applied for Mark	TOWEL & TOWEL
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board

In re Serial No. 85/206,022	:	
	:	
For the mark: TOWEL & TOWEL,	:	Law Office 114
	:	
Applicant: Kehmal Colakel	:	
4301 22 nd St. Ste. 400	:	Exam. Attorney:
Long Island City, NY 11101	:	Eugenia K. Martin
	:	

BRIEF OF THE APPLICANT

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I. INTRODUCTION

COMES NOW the Applicant Kemal Colakel (hereinafter “Applicant”) and through counsel The Trademark Company and provides this Brief of the Applicant in support of its appeal of the examining attorney’s refusal to register the instant mark.

II. STATEMENT OF THE CASE

On December 27, 2010 the Applicant filed an intent-to-use application to register the mark TOWEL & TOWEL on the Principal Register for use in connection with “bath towels; beach towels; children's towels; compressed towels; curtains and towels; face towels; face towels of textiles; football towels; golf towels; hand towels; hand towels of textile; hand-towels made of textile fabrics; hooded towels; household linen, including face towels; Japanese cotton towels (tenugui); kitchen towels; large bath towels; moisture absorbent microfiber textile fabrics for use in the manufacture of athletic apparel, namely, shirts, pants, shorts, jackets, bags, towels and athletic uniforms; quilts of towels; tea towels; terry towels; towel sets; towel sheet; toweling coverlets; towels; towels; towels made of textile materials; towels that may be worn as a dress or similar garment; Turkish towel” in Class 024. The Application received Serial No. 85/206,022.

The examining attorney refused to register Applicant’s mark under Section 2(e)(1) of the Trademark Act (15 U.S.C. § 1052(e)(1)) in an Office Action dated March 28, 2011 because, in the eyes of the examining attorney, the trademark for which registration is sought is merely descriptive of the identified goods.

The Applicant filed a response to the refusal to register the mark on September 27, 2011. However, none of the arguments in support of registration were deemed persuasive by the examining attorney.

After the refusal was made final, this appeal followed.

III. ARGUMENT

Cases involving refusals under Section 2(e)(1) require us to consider the facts as they relate to the relevant factors set out by the Court of Customs and Patent Appeals in *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive of the goods or services to which it relates. TMEP § 1209.01(b). A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

A. Applicant's Mark is Suggestive, Not Descriptive.

A mark is merely descriptive only if it “imparts or conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” *See In re George Weston Ltd.*, 228 U.S.P.Q. 57 (T.T.A.B. 1985). A mark is suggestive, however, if, as applied to the goods, the term requires imagination, thought and perception to reach a conclusion as to nature thereof. The greater the imagination required, the more likely the term is suggestive and not merely descriptive. *See Railroad Salvage of Connecticut, Inc. v. Railroad Salvage, Inc.*, 561 Fed. 1014 (D.C.R.I. 1983).

The examining attorney states that the wording, “TOWEL & TOWEL” is merely descriptive. “The word “towel” is descriptive of the goods, as identified by the Applicant.” See *Office Action* dated March 28, 2011.

When applying this theory to the mark at issue, it is found that any number of products or services could be used in connection with the terms, “TOWEL & TOWEL”. While the services used in connection with the mark in question are, indeed towels, the repeating of the terms can conjure up numerous other images, and there is no instantaneous connection between the “TOWEL & TOWEL” mark and towels. Therefore, Applicant respectfully submits that the mark as a whole must also be considered.

In this instant matter, in its entirety the mark, TOWEL & TOWEL conjures up other possible ideas. While the term, “TOWEL” speaks for itself, the terms together “TOWEL & TOWEL” does not immediately direct the consumer to towels. For instance, a “TOWEL & TOWEL” can also reference a store that sells many items related to bath products, and other home goods. Thus, even if a consumer utilized their imagination, they would still not know immediately what types of goods or services are provided and what its functions are.

B. The Board has Registered Other Marks Containing the Terms “Towel” in Connection with Similar goods.

A thorough examination of registered and approved marks on the Principal Register reveals that the term “TOWEL” in relation to services like those of the Applicant has consistently been treated as suggestive of the respective goods (*See Exhibit A*):

Mark	Reg No.	Goods
THE PATRIOT TOWEL	4296316	Class 24: towels for use in charitable fundraising services for veterans and members of the armed forces
BAITOWEL	4291506	Class 24: Hand towels; Hand towels of textile; Hand-towels made of textile fabrics; Towels; Towels made of textile materials
GREENS TOWEL	4285765	Class 24: Hand towels; Hand towels of textile; Hand-towels made of textile fabrics; Towels; Towels made of textile materials
MYTOWEL	4282475	Class 24: Beach Towels
TIDY TOWELS	4267686	Class 24: Towels made of textile materials

ROUNDY TOWEL ROUNDY TOWEL	4249739	Class 24: Beach Towels
TOWEL DEPOT	4174761	Class 24: Towels; Towels of textile.
MULTITOWEL	3148998	Class 24: Towels
SILVERTOWEL	4085382	Class 24: Hand towels containing silver.
YOUR SOURCE FOR TOWELS	3954848	Class 24: Bath towels; Beach towels; Children's towels; Face towels of textiles; Football towels; Golf towels; Hand towels; Hooded towels; Household linen, including face towels; Kitchen towels; Large bath towels; Tea towels

As such, it is respectfully submitted that it would be inconsistent for the Office to assert that Applicant's mark is merely descriptive of Applicant's goods where the above-referenced marks containing the term "TOWEL" have been permitted to register on the Principal Register and thus not found to be merely descriptive.

In sum, applying the Trademark Trial and Appeal Board's test to the refusal at hand as well as in deference to the treatment of the term "TOWEL" by the Office, application of the degree of imagination test indicates that the relevant consuming public consumer would not form an immediate impression of the features, functions, qualities or characteristics of the goods offered by Applicant by mere sight of the mark.

In view of the above arguments, Applicant believes that the proposed mark is entitled to registration on the Principal Register. However, if the Examining Attorney remains unsure, she is respectfully reminded that because of the thin line between suggestive and descriptive marks, it is the practice of the USPTO to resolve doubt in Applicant's favor and publish the mark for opposition. *See In re Morton-Norwich Products, Inc.* 209 U.S.P.Q. 791 (TTAB 1981); and *In re Grand Metropolitan Foodservice Inc.* 30 U.S.P.Q.2d 1974, 1976 (TTAB 1994).

Conclusion

WHEREFORE the Applicant Kemal Colakel, by counsel, respectfully requests that the refusals under Section 2(e)(1) of the Trademark Act of 1946 be withdrawn and the mark be allowed for publication on the Principal Register.

Respectfully submitted this 11th day of March, 2013

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